

REPLY

Serial No. 09/808,558
Atty. Docket No. GP068-05.CN3**Remarks**

Claims 422-429, 431-433, 440-448, 450-452, 459 and 461-479 are presently pending in the subject application. Claims 441-448, 450-452, 459, 461-463, 465 and 473-479 are withdrawn.

Reconsideration and allowance are respectfully requested in view of the above amendments and the following remarks.

Applicants wish to thank the Examiner for granting their undersigned representative a telephonic interview today. The subject matter discussed during the interview is fully reflected in the amendments to claims 422 and 441 herein and in the remarks which follow.

Status of the Application

Applicants note that the Examiner's listing of the currently pending claims incorrectly includes claims 453-458. These claims were canceled in Applicants' Reply dated January 19, 2004.

Rejoinder of the Process Claims

The claims elected for examination in the instant application are all directed to a product (*i.e.*, a hybridization assay probe). Therefore, should the Examiner find claim 422, the only independent claim currently being examined, to be allowable, then Applicants respectfully request rejoinder of the process claims, which all depend from claim 422. *See* MPEP § 821.04.

Rejection Under 35 U.S.C. § 112

Claims 422-428, 431-433, 440 and 466-472 stand rejected by the Examiner under 35 U.S.C. § 112, first paragraph, as being indefinite. To clarify, claims 422 and 441 have been amended herein to indicate that a stable, double-stranded "complex" is formed between the probe and the nucleic acid analyte and that the complex comprises a single-stranded form of the probe. This amendment to the claims is supported by the language at page 18, lines 4-6 of the specification. Moreover, this language distinguishes the claimed probes over the stem-loop oligonucleotides of U.S. Patent No. 5,514,546 to Kool, since the stem-loop oligonucleotides of Kool remain partially

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double-stranded when complexed with the target. Accordingly, Applicants submit that the language of the presently pending claims is definite and patentable and, for this reason, withdrawal of the Examiner's Section 112 rejection is hereby respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 422-428, 431-433, 440 and 466-472 stand rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by Agrawal *et al.* (International Publication No. WO 94/01550). Applicants respectfully traverse this rejection for the reasons that follow.

Agrawal is cited by the Examiner for, *inter alia*, disclosing probes comprising both a detectable label (*i.e.*, acridine or ethidium) and first and second base regions capable of hybridizing to each other under nucleic assay conditions to form a hybrid containing at least one ribonucleotide modified to include a 2'-O-alkyl substitution to the ribofuranosyl moiety. What Agrawal actually discloses are alternative embodiments for hyperstabilizing a self-stabilized oligonucleotide, one of which is to introduce one or more 2'-O-methyl ribonucleotides into the self-complementary region of the oligonucleotide and the other is to incorporate one or more intercalating agent molecules into the self-complementary region of the oligonucleotide. *See* Agrawal at paragraph bridging pages 16 and 17. Agrawal further provides no suggestion or motivation for using 2'-O-methyl ribonucleotides and intercalating agent molecules in the self-complementary region of the self-stabilized oligonucleotides. Because Agrawal fails to disclose or suggest the presently claimed probes, withdrawal of the Examiner's Section 102 rejection is hereby respectfully requested.

Conclusion

In view of the above amendments and remarks, Applicants submit that the subject application is in condition for allowance and early Notice to that effect is respectfully requested.

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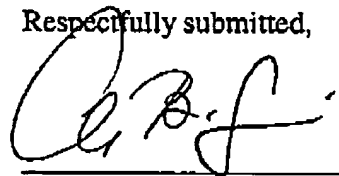
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No fee is believed due in connection with this Reply. If Applicants are mistaken, then please charge any amounts due to Deposit Account No. 07-0835 in the name of Gen-Probe Incorporated.

Certificate of Transmission

I hereby certify that this correspondence (and any referred to as attached) is being sent by facsimile to 571-273-8300 on the date indicated below to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Respectfully submitted,



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